

**REMARKS**

Claims 2-9 are currently pending in the present application.

The Applicant is requesting entry of the foregoing proposed amendments in order to place the application into condition for allowance.

The January 6, 2004 Final Office Action entered a new grounds of rejection of claims 2-9, maintaining these claims to be unpatentable under 35 U.S.C. § 103(a) over European patent document EP 1 031 367 A1 ("EP '367") in view of U.S. Patent No. 6,485,635 B1 to Gandini, *et al.* ("Gandini"). In addition, an objection to claim 9 and a related 35 U.S.C. § 112, second paragraph rejection of claims 2-7 were entered does to a typographic error in claim 9.

The Applicant appreciates the Examiner's helpful comments regarding the informality in claim 9. As suggested, the Applicant is requesting amendment of claim 9 to correct "second filter assembly" to recited "second seal assembly." Entry of this amendment and withdrawal of the pending claim objection and § 112, second paragraph rejection is respectfully requested. The Applicant is also requesting amendment of claim 9 to clarify that the first seal assembly radially seals the return flow channel to prevent unfiltered fluid flow into the return flow channel during filter operation.

Response to § 103(a) Rejection: The Applicant respectfully traverses the rejection of claims 2-9 as unpatentable under § 103(a) over EP'367 in view of Gandini on the grounds that these references, either alone or in combination, fail to teach or suggest all the features of the present invention recited in independent claim 9 and its dependent claims 2-8.

The present claims are directed to a filter arrangement in which draining of the filter housing during filter replacement may be conducted in a controlled manner, with a filter seal arrangement that is highly tolerant of filter axial dimension variations. As shown in Figs. 1-3, because the return flow channel is *radially* sealed by radial seals (12, 20 and 30) against *axial* housing walls (13, 21 and 31, respectively), a complete sealing of the interface between the return flow channel and the unfiltered fluid in the housing is achieved, even if the axial length of the filter element is below a minimum desired length. Moreover, because the first and second seals remain engaged with housing walls during the initial stages of filter element removal, a high degree of control of the draining of the housing can be maintained.

In contrast, EP '367's *axial* seal arrangement is intolerant of filter element length variations. It would take only a slight production variation in the length of either the filter or the housing to result in insufficient clamping force between axial seal 15 and the end of wall 4, which in turn would allow leakage of unfiltered oil into the EP '367 return channel. EP '367's axial seal also provides poor control of housing drainage during filter removal, as *any* axial movement of the filter element immediately results in the return channel becoming unsealed; indeed, merely removing the housing cover may remove sufficient pre-load pressure from the seal to permit uncontrolled drainage of unfiltered fluid. EP '367 thus does not teach or suggest the presently claimed radial sealing arrangements.

EP '367's deficiencies are not cured by Gandini. Gandini is cited as

teaching a seal which reduces backflow of unfiltered liquid. Without addressing or conceding this point, the Applicant notes that in any event, Gandini contains no teaching or suggestion regarding radial seal arrangements as in the present invention. There thus is no suggestion for the combination of this reference with EP '367 to obtain the presently claimed radial sealing arrangements. Moreover, due to the different approach of the Gandini seal arrangements, there would be no motivation for such a combination.

For the foregoing reasons, the Applicant respectfully submits that EP '367 and Gandini, either alone or in combination, fail to teach or suggest the invention recited in claims 2-9, and thus these claims are patentable under § 103(a) over these references. Reconsideration and withdrawal of the pending § 103(a) rejection of claims 2-9 is respectfully requested.

### CONCLUSION

In view of the foregoing requested amendments and remarks, the Applicant respectfully submits that, upon entry of the foregoing amendments, the claims will be in condition for allowance. Accordingly, entry of the foregoing amendments and issuance of a Notice of Allowance for claims 2-9 is respectfully requested.

If there are any questions regarding this amendment or the application in general, a telephone call to the undersigned would be appreciated since this should expedite the prosecution of the application for all concerned.

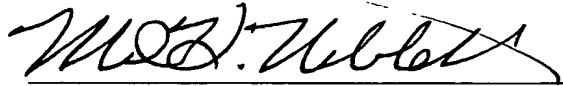
If necessary to effect a timely response, this paper should be considered as a petition for an Extension of Time sufficient to effect a timely response, and

please charge any deficiency in fees or credit any overpayments to Deposit

Account No. 05-1323 (Docket #178/50786US).

May 6, 2004

Respectfully submitted,

A handwritten signature in black ink, appearing to read "J.D. Evans", written over a horizontal line.

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